

REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated November 13, 2009 ("*Office Action*"). Applicants respectfully request reconsideration and favorable action in this case in light of the remarks below.

**Interview Summary**

Applicants' Attorneys conducted a telephonic interview with Supervisory Examiner Alexander Kalinowski on January 8, 2010. Applicants submit this summary of the telephonic interview to record Applicants' understanding of the substance of the interview.

Applicants thank Examiner Kalinowski for the opportunity to conduct the telephonic interview. During the interview, Examiner Kalinowski and Applicants' Attorney discussed proposed amendments to the pending Claims that would overcome the previous rejections under 35 U.S.C. § 101 as being directed to non-statutory subject matter, and 35 § U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner Kalinowski suggested that Applicants amend the preamble of Claim 50 to recite a computer readable medium comprising computer readable instructions that, when executed by one or more computer systems, perform the steps recited in original Claim 50. Examiner Kalinowski agreed that such an amendment would overcome the rejections under 35 U.S.C. §§ 101 and 112, second paragraph, mentioned above.

**Rejections under Section 101 and 112, second paragraph**

The *Office Action* rejects Claim 50 under U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The *Office Action* alleges that Claim 50 is "intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 U.S.C. 101, but that is incorrect. (*Office Action*, p. 3.) The *Office Action* also rejects Claim 50 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants traverse. For the purposes of advancing prosecution, however, Applicants amend Claim 50 as suggested by Examiner Kalinowski on January 8, 2010 during the telephonic interview described above. As Examiner Kalinowski acknowledged during the interview, Claim 50, as

amended, recites statutory subject matter under 35 U.S.C. § 101 and is sufficiently definite to overcome the Examiner's rejection under 35 U.S.C. § 112, second paragraph. Accordingly, Applicants' amendment renders the Examiner's rejections under 35 U.S.C. §§ 101 and 112, second paragraph, moot.

**Rejection under Section 112, first paragraph**

Claim 50 is rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner alleges that Claim 50 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Applicants traverse.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003); M.P.E.P. 2163(I). The Examiner has the initial burden of presenting by a preponderance of the evidence **why** a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. M.P.E.P. 2163(III)(A) (emphasis added).

The *Office Action* fails to satisfy this requirement. Specifically, the *Office Action* alleges, **without any explanation**, that "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." (*Office Action*, p. 2.) The *Office Action* provides **no** evidence regarding "**why** a person skilled in the art would not recognize in the Applicants' disclosure a description of the invention" as required by M.P.E.P. 2163(III)(A) (emphasis added). Accordingly, the *Office Action* fails to meet the burden for a rejection under section 112, first paragraph.

Moreover, the M.P.E.P. makes clear that "the subject matter of the claim **need not** be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the written description requirement." M.P.E.P. 2163.02 (emphasis added). To comply with the written description requirement, each claim limitation must be expressly,

**implicitly, or inherently** supported in the originally filed disclosure.<sup>1</sup> M.P.E.P. 2163(II)(A)(3)(b).

The *Office Action* alleges that a computer readable medium is not disclosed in the original application, but that is incorrect. For example, the originally-filed application recites:

Further, the method 10 could be programmed as a financial planning application and executed by one or more computer systems . . . . The information collected in step 20 can be gathered verbally, in writing (i.e., by filling out a questionnaire), or by one or more user interface screens on a computer system.

(Application, par. [0023] (emphasis added).) To a person skilled in the art, those passages expressly, implicitly, or inherently support a “computer readable storage medium” as recited in amended Claim 50. While the particular phrasing used in the claim may not appear explicitly in the specification, it is at least implicit or inherent, and one of ordinary skill in the art would appreciate that the Specification discloses the recited features of Claim 50. For at least these reasons, Claim 50 is fully supported by the originally-filed application.

### **Section 102 Rejections**

Claim 50 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,933,815 issued to Golden (“*Golden*”). Applicants traverse.

For a reference to anticipate a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). With this threshold requirement in mind, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation using *Golden*.

Regarding *Golden*, the *Office Action* merely alleges that the reference discloses “one or more computer systems” and “a financial planning application embodied on a computer readable medium.” As explained above, Applicants have amended Claim 50, and that language no longer appears in that claim. Additionally, the Examiner fails to even address many of the limitations recited in amended Claim 50. (*Office Action*, pp. 4-5 (failing to cite any passages of *Golden* as allegedly disclosing numerous features of Claim 50).) For this

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<sup>1</sup> In addressing the Examiner’s rejection, Applicants refer to example discussions within the Specification; however, reference to these portions should not be used to limit Applicants’ claims.

reason alone, the Examiner has failed to establish a *prima facie* case of anticipation using *Golden*.

Moreover, *Golden* teaches a program that provides guaranteed lifetime income with a measure of liquidity using an initial contribution of assets. *Golden*, Abstract. According to *Golden*, periodic payments during one period are guaranteed for a fixed duration, and payments during a second period are life contingent. *Golden*, Abstract.

But *Golden* fails to disclose each and every element of Claim 50. For example, *Golden* fails to disclose “calculating a projected retirement income for the husband and the wife in a bridge scenario, the projected retirement income in the bridge scenario including an estimate of yearly inflation-adjusted after-tax income from” the recited features. *Golden* also fails to disclose “calculating a projected retirement income for the husband and the wife using an alternative funding approach,” or “comparing the calculated projected retirement income for the husband and the wife in the bridge scenario to the projected retirement income for the husband and the wife using the alternative funding approach,” as recited in Claim 50.

Consequently, *Golden* does not disclose, and the Examiner does not allege that *Golden* discloses, each and every feature of Claim 50. For at least these reasons, Claim 50 is allowable. Applicants respectfully request reconsideration and allowance of Claim 50.

### **No Waiver**

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner’s rejections.

**Conclusion**

Applicants have made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicants respectfully request reconsideration and allowance of all pending claims.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicants invite the Examiner to contact their attorney at the number provided below.

The Commissioner is hereby authorized to charge the required fee of \$810.00 to file a Request for Continued Examination (RCE) and, to the extent necessary, charge any other fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,  
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